

REMARKS

By this Amendment, Applicants have amended claims 1, 2, 5, 8, 9, 11, 13, 15, 18, 19, 23-25, 27, 34, 36, 42, 46, 47, 49, 56, 69, 75, 106, 107, 128, 136, 155, 163, 178, 186, 188-190, 192-195. No new matter has been added. Claims 1-219 are pending on the merits.

As an initial matter, Applicants appreciate the Examiner's withdrawal of the Restriction Requirement and the indication that claims 5-7, 19-22, 25, 26, 36-41, 43-46, 55-57, 69-72, 75, 76, 85-90, 92-97, 109-113, 128, 136-164, 178, 186, 187, 193, and 200-219 contain allowable subject matter.¹ By this Amendment, Applicants have rewritten claims 5, 19, 25, 56, 69, 75, 128, 136, 155, 163, 178, 186, and 193 in independent form, including all of the subject matter of any intervening claims. Accordingly, claims 5, 19, 25, 56, 69, 75, 128, 136, 155, 163, 178, 186, and 193 should be allowable.

In the Office Action, 1-4, 8-18, 23, 24, 27-35, 42, 47-54, 58-68, 73, 74, 77-84, 91, 98-108, 114-127, 129-135, 165-177, 179-185, 188-192, and 194-199 were rejected either under 35 U.S.C. § 102(b) based on McFarlane et al. (U.S. Patent No. 5,311,293), or under § 103(a) based on MacFarlane et al. either alone or in combination with either Kamen et al. (U.S. Patent No. 5,150,791) or Stenz (U.S. Patent No. 1,741,080). The only independent claims that have been rejected are claims 1, 52, 106, and 188. Claims 1, 52, and 106 have been rejected under 35 U.S.C. § 102(b) based on

¹ The Examiner has indicated claims 138-164 and 200-219 are allowed. Applicants note, however, that claims 138-164 and 200-212 depend from claim 52, which has been rejected. Accordingly, Applicants believe the Examiner intended to indicate that claims 138-164 and 200-212 would be allowable if they would be rewritten in independent form.

MacFarlane et al., and claim 188 has been rejected under 35 U.S.C. § 103(a) based on Kamen et al. in combination with MacFarlane et al.

Applicants have amended claims 1 and 106, thereby obviating the § 102(b) claim rejection based on the MacFarlane et al. reference. Furthermore, claim 52 recites subject matter that is neither disclosed nor suggested by MacFarlane et al. Applicants have also amended claim 188, thereby obviating the § 103(a) rejection based on Kamen et al. in combination with MacFarlane et al. Therefore, independent claims 1, 52, 106, and 188 should be allowable.

Independent Claim 1

Amended independent claim 1 recites a matching chart including “a plurality of comparison samples. . . .” The MacFarlane et al. reference does not disclose at least that subject matter recited in amended claim 1. Rather, the MacFarlane et al. reference discloses a method and instrument for identifying categories of skin coloration for compatibility with, for example, colors of clothing and makeup. The reference refers to the importance of calibrating a commercial colorimeter using a standard, which avoids the phenomenon sometimes known as metamerism, whereby objects that look alike (have the same perceived color) under some kinds of light sources or to some observers do not match under other types of light sources or to other observers. Col. 5, lines 42-58. Because of metamerism, commercial colorimeters may not read colors the same as the average human observer would under a daylight-type light source employed for visual observation, hence leading to an error in colorimeter calibration. Col. 5, lines 58-62. The MacFarlane et al. reference discloses using an improved

primary standard to calibrate a commercial colorimeter by selecting the skin of a subject whose skin color measurements were highly reproducible and in the approximate center of the range of skin colors of the human population. Col. 5, lines 63-66. The spectral reflectance factors of the skin of this subject were carefully measured at pre-selected wavelengths. Col. 5, line 66, through col. 6, line 3. (See columns 1 and 2 of Table II.) By using established techniques of computer color matching, carried out on a color measuring instrument, a colorant formulation matching this skin color was developed. Col. 6, lines 3-8. The spectral reflectance factors for this match are given in column 3 of Table II. Col. 6, lines 8-9. The spectral reflectance factors given in column 3 approximately match those of column 2, tending to indicate an absence of metamerism. Table II shows that the column 2 and column 3 values match to within 0.27-0.36 units, and MacFarlane et al. notes that this represents a difference, which is "less than can be perceived by human color vision, for daylight, incandescent light, and cool white fluorescent light, the three most commonly used light sources for the proposed applications." Col. 6, lines 11-17.

The MacFarlane et al. reference, however, does not disclose a matching chart including a plurality of comparison samples as recited in claim 1. MacFarlane et al. discloses a single primary standard for calibrating a commercial colorimeter, which avoids the phenomenon of metamerism. Therefore, the MacFarlane et al. reference does not disclose or suggest all of the subject matter recited in Applicants' amended independent claim 1, and claim 1 should be allowable.

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Independent Claim 52

Applicants' independent claim 52 recites a system including "a plurality of comparison samples. . . ." The MacFarlane et al. reference does not disclose at least that subject matter recited in independent claim 52. As outlined above with respect to claim 1, MacFarlane et al. discloses a single primary standard for calibrating a commercial colorimeter, which avoids the phenomenon of metamerism. Therefore, the MacFarlane et al. reference does not disclose or suggest all of the subject matter recited in Applicants' independent claim 52, and consequently, claim 52 should be allowable.

Independent Claim 106

Amended independent claim 106 recites a method of making a plurality of comparison samples. . . ." The MacFarlane et al. reference does not disclose at least that subject matter recited in amended independent claim 106. Rather, the MacFarlane et al. reference discloses a method for identifying categories of skin coloration for compatibility with colors of clothing and makeup by providing a single primary standard for calibrating a commercial colorimeter, which avoids the phenomenon of metamerism. Thus, MacFarlane et al. does not disclose or suggest at least a method of making a plurality of comparison samples. Therefore, MacFarlane et al. does not disclose or suggest all of the subject matter recited in Applicants' amended independent claim 106. As a result, Applicants' amended independent claim 106 should be allowable.

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Independent Claim 188

Amended independent claim 188 recites a method for manufacturing packaging for a product including “providing a plurality of comparison samples . . . and providing at least one of the comparison samples on packaging. . . .”

Applicants’ independent claim 188 was rejected under 35 U.S.C. § 103(a) based on Kamen et al. in combination with MacFarlane et al. Applicants respectfully traverse that rejection because the Kamen et al. and MacFarlane et al. references, taken alone or in combination, fail to disclose or suggest at least the above-recited subject matter in claim 188. Because there is no legally proper motivation or suggestion to modify the Kamen et al. reference in the hypothetical manner proposed in the Office Action, Applicants respectfully traverse the § 103(a) rejection of claim 188 based on Kamen et al. in combination with MacFarlane et al.

In order to establish a *prima facie* case of obviousness, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art” to modify a reference teaching. M.P.E.P. § 2143. And “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” § 2143.01 (emphasis added) (citation omitted). Therefore, since neither the Kamen et al. reference nor the MacFarlane et al. reference provides any suggestion or motivation for modifying the Kamen et al. method in the hypothetical manner proposed by the Office Action, there is no legally proper suggestion or motivation to make the Office Action’s proposed hypothetical modification.

The Office Action's rejection statement concludes that "it would have been obvious . . . to have the comparison sample of Kamen's system have a reflectance spectrum substantially similar to a reflectance spectrum of a keratinous element, so that the sample and the element would appear to have the same color under at least two different illuminants to avoid metamerism." Office Action at 14. Applicants respectfully traverse that conclusion because there is no legally proper suggestion or motivation in either the Kamen et al. reference or the MacFarlane et al. reference to modify the Kamen et al. method in the hypothetical manner proposed in the rejection statement.

In particular, the Kamen et al. reference discloses container 10, which may be fabricated from cardboard, plastic, or any suitable material. The container 10 may house a cosmetic product, which may have a color associated therewith, such as a face powder, lipstick, or rouge. The container 10 may be associated with a module 12, which serves to seal the container 10. The module 12 may contain an exact color composition, which was utilized to fabricate a cosmetic. The Kamen et al. reference, however, makes no mention of metamerism, or even any problem that might relate to metamerism.

As outlined above, the MacFarlane et al. reference discloses a method for identifying categories of skin coloration for compatibility with colors of clothing and makeup by providing a single primary standard for calibrating a commercial colorimeter, which avoids the phenomenon of metamerism. Since the standard is used merely for calibrating a colorimeter that in turn is used to identify categories of skin coloration, there is no legally proper suggestion or motivation for "hav[ing] the comparison sample of Kamen's system have a reflectance spectrum substantially similar to a reflectance

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spectrum of a keratinous element, so that the sample and the element would appear to have the same color under at least two different illuminants to avoid metamerism." As a result, the Office Action fails to establish a *prima facie* case of obviousness.

Accordingly, Applicants' amended independent claim 188 should be allowable.

Conclusion

For at least the reasons set forth above, independent claims 1, 5, 19, 25, 52, 56, 69, 75, 106, 128, 136, 155, 163, 178, 186, 188, and 193 should be allowable.

Dependent claims 2-4, 20-24, 26-51, 53-55, 57-68, 70-74, 76-105, 107-127, 129-135, 137-154, 156-162, 164-177, 179-185, 187, 189-192, and 194-219 depend from those independent claims. Consequently, the dependent claims should be allowable for at least the same reasons the independent claims are allowable.

Therefore, Applicants respectfully request the reconsideration of this application, the withdrawal of the outstanding objections and claim rejections, and the allowance of claims 1-219.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicants' undersigned representative at 571-203-2739.

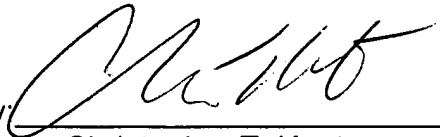
Applicants respectfully submit that the Office Action contains assertions concerning the related art and/or the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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